

to different text fonts selectable for the unique information indicating product," as recited in independent claim 1.

However, the Office Action takes Official Notice and asserts that displaying text in various fonts in order to vary the appearance of the text is well known to include in any method of customizing the appearance of graphical information containing text. The Office Action further asserts that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen to include this function in order to allow the customer to have greater control over the appearance of the product, and since so doing could be performed readily and easily by any person of ordinary skill in the art. These assertions are respectfully traversed.

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious. *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991) (emphasis added). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

As discussed above, a rejection under 35 U.S.C. §103(a) must be based on facts and include a showing of a suggestion, teaching or motivation to combine the prior art references. The Office Action's assertion on page 3 with respect to the alleged teaching, suggestion or

motivation to combine the references, that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen as to include the functionality to selectably display the text in different fonts is allegation is an example of impermissible hindsight reasoning. The Office Action has not provided a motivation that teaches or suggests including this feature.

Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Von Rosen displays graphic images that are not defined by fonts. Thus, by modifying von Rosen to display various fonts as recited in claim 1, would change the principle of operation of von Rosen.

Moreover, the Office Action failed to provide adequate support for taking a Official Notice that it is well known in the art to provide a plurality of preview images corresponding to different text fonts selectable for the unique information indicating product, as recited in claim 1. Namely, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F. 3d at 1385, 59 USPQ 2d at 1697. In limited circumstances, it is appropriate for an Examiner to take official notice of facts not in the record or rely on "common knowledge" in making a rejection. Such rejections, however, should be judicially applied. To support his or her conclusion of common knowledge, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The notice of facts beyond the record, which may be taken by the Examiner, must be "capable of such instant and unquestionable

demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (citing *In re Knapp Monarch Co.*, 296 F. 2d 230, 132 USPQ 6 (CCPA 1961)).

This feature is not capable of such instant and unquestionable demonstration as to defy dispute. Thus, the Office Action must provide support for its Official Notice.

Thus, for at least these reasons, claim 1 is patentable over von Rosen. Further, claims 2-4 and 6-9, which depend from claim 1, are also patentable over von Rosen for at least the reasons discussed with respect to claim 1, as well as the additional features recited therein.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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